APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,432	03/08/1999	PHILLIP Y. GOLDMAN	14531.46	3073

22913   7590   06/05/2002

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EXAMINER
BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary	●	09/264,432 ●	GOLDMAN ET AL.
		Examiner	**Art Unit**
		Scott Beliveau	2614

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-32* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *08 March 1999* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4, 5*.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

U.S. Patent and Trademark Office
PTO-326 (Rev. 04-01)   Office Action Summary   Part of Paper No. 7

Drawings

1.   Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that

which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or

corrected drawings are required in reply to the Office action to avoid abandonment of the

application. The objection to the drawings will not be held in abeyance.

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because

reference character "110" has been used to designate both the "Monitor TV Viewing" step

(Figure 4) and the "Client System" (Figure 3B). Based on the specification, it appears that

"Monitor TV Viewing" should be identified as element 410 (Page 22, Lines 14-15). A

proposed drawing correction or corrected drawings are required in reply to the Office action

to avoid abandonment of the application. The objection to the drawings will not be held in

abeyance.

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because of the

following:

   a.   They do not include "remote control device 14" mentioned in the description

        (Page 14, Lines 2-3; see disclosure objection [item 4]).

   b.   They do not include reference sign(s) [80] mentioned in the description (Page 20,

        Line 8).

A proposed drawing correction or corrected drawings are required in reply to the Office

action to avoid abandonment of the application. The objection to the drawings will not be

held in abeyance.

Specification

4.   The abstract of the disclosure is objected to because Line 19 contains extraneous

information ("G:\DATAPAT\WORDAT\1453146.DOC"). Correction is required. See

MPEP § 608.01(b).

5.   The disclosure is objected to because of the following informalities:

   a. "modem pool 14" should be amended to read "modem pool 12" in order to be

   consistent with the previously disclosed element numbering scheme (Page 12,

   Lines 11-4, 16-17);

   b. "remote control device 14" (Page 14, Lines 2-3) should be amended with a new

   element number because it uses the same element number as the "bi-directional

   data connections 14" (Page 12, Lines 11-14);

   c. "implements" should be amended to read "implement" (Page 13, Line 12);

Appropriate correction is required.

6.   The use of the trademark "WebTV" has been noted in this application (Page 15, Lines 5-

15; Page 17, Lines 13-15, 19-21). It should be capitalized wherever it appears and be

accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary

nature of the marks should be respected and every effort made to prevent their use in any

manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

7.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent

any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to

point out the inventor and invention dates of each claim that was not commonly owned at the

time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 1-9, 12, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Cohn et al. (US Pat No. 6,317,791), in view of Robinson (US Pat No. 5,918,014), and in

further view of Breese et al. (US Pat No. 6,353,813).

In reference to claim 1, note the Cohn et al. reference shows the schematic structure of a

communications network for use with an "information retrieval system" such as the WebTV©

client terminal [10] (Figure 4). The client terminal [10] facilitates shared screen viewing of

television/internet content. Subsequently, it handles both the "request" for and "display" of

"information documents" or HTML web pages (Col 1, Lines 34-64; Col 6, Lines 28-67).

Advertisements are inserted into the retrieved "information documents" based on a selection

program which chooses the "most appropriate" advertisement for the presentation (Col 7,

Lines 52-55). The Cohn et al. reference is silent, however, as to details of this advertisement

selection process for selecting the "most appropriate" advertisement. The Robinson

reference teaches that automated collaborative filtering (ACF) techniques may be used to

"select" targeted advertisements to present to users based on their "community" or profile

(Col 4, Lines 8-38). It would have been obvious to one of ordinary skill in the art at the time

of the invention to utilize the Robinson teachings of "advertisement selection" with the

advertisement selection process of Cohn et al. for the purposes of providing a technique for

selecting the "most appropriate" advertisement for the user based on their interests (Cohn et

al.: Col 7, Lines 48-55). The "selected" ads are subsequently inserted into the "information

document" as appropriate (Robinson: Col 4, Lines 44-50). The Robinson reference teaches

that user profiles may be constructed "to further character the user" using a combination of

user supplied demographic data, and tracking or "monitoring" information obtained through

embedded browser monitoring software (Col 6, Lines 54-58; Col 10, Lines 65-67 – Col 11,

Lines 1-10). The collaborative filtering method utilized by the Robinson reference is not

limited to just using Internet tracking information and demographic information to construct

user profiles. The Breese et al. reference discloses an enhanced collaborative filtering

method, which utilizes a number of attributes such as television shows viewed, to improve

interest matching (Col 3, Lines 40-54; Col 4, Lines 2-6; Figure). It would have been obvious

to one of ordinary skill in the art at the time of the invention to enhance the "community" or

profile generation method outlined in the Robinson reference with the television viewership

attribute teachings of the Breese et al. reference for the purposes of developing a more robust

data set from which to develop a closer profile match.

In reference to claims 2-4, the technique of "inserting data representing the selected advertisement" is well known in the art (see Brown et al. (US Pat No. 5,887,133) – Figures 2 and 3). The Robinson reference teaches that the viewer profile information may be stored either locally or remotely on a central database server and that decisions as to which ads are to be displayed are determined where the profile resides (Col 7, Lines 24-34). It is well understood by those of ordinary skill in the art that a typical "ISP" architecture includes servers (Cohn et al.: Figure 4 illustrates a basic networked computing architecture wherein the "host server" [98] could be an ISP terminal server or RADIUS server). As such, the teachings of the Robinson reference wherein the advertisements are inserted on servers may also meet the claimed "ISP" limitation.

In reference to claims 5-6, the Cohn et al. reference teaches that information such as advertisements may be "pre-downloaded" and stored on the client system (Col 3, Lines 9-26; Figure 7).

Claim 7 is met as aforementioned wherein the "information document" is a web page in HTML format (Cohn et al.: Col 6, Lines 61-63).

Claims 8 and 12 are met as aforementioned. The "profile" may be constructed "to further characterize the user" using a combination of user supplied demographic data, and tracking information (Robinson: Col 6, Lines 54-58; Col 10, Lines 65-67 – Col 11, Lines 1-10).

Claim 9 is met by the aforementioned combination of the Cohn et al., Robinson, and Breese et al. references. These references disclose a method whereby a "server" uses "compiled" user information to "select" and "insert" targeted advertisements into user "requested" documents. These documents are subsequently "transmitted" to and "displayed"

on the user terminal. In addition to the aforementioned, the Robinson reference discloses that

"profile" may be "transmitted" from the client system to the server (Col 8, Lines 4-20).

Claim 20 is met by the aforementioned combination. The Cohn et al. WebTV© client

terminal [10] embodiment contains "computer readable" memory [46, 48] in which

executable code may be stored.

Claims 21-23 and 25 are met by the aforementioned combination wherein the "profile"

may be "transmitted" from the client system to the server or retained locally (Robinson: Col

8, Lines 4-20). The viewer profile information would subsequently be used to determine

which ads are to be "inserted" and "displayed" (Col 7, Lines 24-34) as is well understood in

the art.

Claim 24 is met wherein, the Cohn et al. reference teaches that data may be "pre-

downloaded" and stored in physical memory on the client system (Col 3, Lines 9-26; Col 8,

Lines 9-12).

10.   Claims 10, 26, 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Cohn et al. (US Pat No. 6,317,791), in view of Robinson (US Pat No. 5,918,014), in further

view of Breese et al. (US Pat No. 6,353,813), and in still further view of Bedard (US Pat No.

5,801,747).

Claim 10 is met by the aforementioned combination of the Cohn et al., Robinson, and

Breese et al. references. These references, while disclosing that television monitoring

information is utilized in defining profile attributes, are silent as to the method of gathering

this information. The Bedard reference discloses a method and apparatus for monitoring

television viewing and using this information in conjunction with an electronic programming

guide (EPG) to determine a "viewer profile" of preferred viewing categories. In the

disclosed embodiment the information is used to configure an EPG based on these

preferences, however the method is adaptable to broader applications (Col 2, Lines 5-45; Col

2, Lines 66-67 – Col 3, Lines 1-3). The reference further teaches that this profile may be sent

to broadcasters to target commercials and that it may used in conjunction with the internet to

"pull" information that may be of interest to the viewer (Col 8, Lines 16-21, 51-63). This

profile may be sent to broadcasters to target advertisements. It would have been obvious to

one of ordinary skill in the art at the time of the invention to utilize the monitoring and

profiling teachings of Bedard in combination with the aforementioned Cohn et al., Robinson,

and Breese et al. teachings in order to provide a method by which to efficiently monitor

viewership in order to target internet advertisements similar to targeted television broadcast

commercials.

Claim 26 is similarly met wherein it is additionally taught by the Cohn et al. reference

that the WebTV© client terminal [10] embodiment contains "computer readable" memory

[46, 48] in which executable code may be stored.

Claims 28-31 are met in view of the aforementioned combination. Figure 1 of the Cohn

et al. reference illustrates a "home entertainment system" comprising an Internet browsing

device [10] embodied by a WebTV© client terminal, a set-top box [12], and a television [14]

capable of "receiving" and "displaying" a television broadcast signal [20] or an "information

document" via a telephone [24] or an ISCN connection [26]. As aforementioned, the

combined references also include the means "for monitoring the television programming"

comprising "an electronic programming database monitoring unit," disclosed in the Bedard reference.

11.   Claims 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al. (US Pat No. 6,317,791), in view of Robinson (US Pat No. 5,918,014), in further view of Breese et al. (US Pat No. 6,353,813), and in still further view of Brodsky (US Pat No. 5,809,471).

Claim 11 is met by the aforementioned combination of the Cohn et al., Robinson, and Breese et al. references. These references, while disclosing that television monitoring information is utilized in defining profile attributes, are silent as to the method of gathering this information. The Breese et al. further discloses that the attributes may comprise a "set" of information (Col 5, Lines 60-67 – Col 6, Lines 1-21). The Brodsky reference discloses a method for extracting "keywords" from closed-captioning information of the most recently received program information. This information is used to compile a "dictionary" of terms that are used to retrieve supplemental information pertaining to the programming currently being watched (Col 3, Lines 51-67 – Col 4, Lines 1-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the extracted keyword teachings of the Brodsky reference in combination with the attribute "set" composition teachings of the Breese et al. reference in order to identify the content of viewed programming such that profiles may be created in order to deliver targeted advertisements related to that content.

Claim 27 is similarly met wherein it is additionally taught by the Cohn et al. reference that the WebTV© client terminal [10] embodiment contains "computer readable" memory [46, 48] in which executable code may be stored.

12.   Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al.

(US Pat No. 6,317,791) in view of Bedard (US Pat No. 5,801,747).

Claim 13 is met by the aforementioned combination of the Cohn et al. and Breese et al.

references. As aforementioned, the Cohn et al. reference illustrates (Figure 4) a schematic

structure of a communications network for use with an "information retrieval system" such

as the WebTV© client terminal [10]. As shown in Figure 2, the terminal facilitates shared

screen viewing between television/internet content, and as such facilitates both the "request"

for and the "display" of "information documents" (Col 1, Lines 34-64; Col 6, Lines 28-67).

The reference while, disclosing that information may be "pushed" to it, is silent as to the

method for selecting "pushed" information based on monitoring television programming (Col

2, Lines 44-55). The Bedard reference discloses a method and apparatus for monitoring

television viewing. The reference teaches that this information may be used in conjunction

with an electronic programming guide (EPG) to determine a "viewer profile" of preferred

viewing categories (Col 2, Lines 5-45; Col 2, Lines 66-67 – Col 3, Lines 1-3). The reference

further teaches that this profile may be used to "pull" targeted information from the Internet

that may be of interest to the viewer and to subsequently "push" it to the user in accordance

with the television model of interaction (Col 8, Lines 16-21, 51-63). It would have been

obvious to one of ordinary skill in the art at the time of the invention to utilize the

monitoring, profiling, and push/pull information retrieval teachings of Bedard in combination

with the Cohn et al. apparatus in order to provide a method with which to effectively deliver

information of interest to the user.

In reference to claims 14-15, the Cohn et al. reference discloses that the host server may

provide supplemental information including "news" and "television program guides" (Col 1,

Lines 46-49). It is well understood that "Television program guides" may contain

information pertaining to the program content.

Claim 16 is met wherein the "step of selecting the plurality of information categories" is

based on the user input, since the user's input is used to select which channels to watch.

Infrequently watched program "categories" are dynamically removed from the preferred list

(Bedard: Col 5, Lines 16-33). Additional methods wherein the viewer selects chooses from

a plurality of categories are well known in the art (Young et al. (US Pat No. 5,353,121) Col

16, Lines 33-42; Col 14, Lines 47-67 – Col 15, Lines 1-22).

In reference to claims 17-18, the Bedard reference meets the claimed language wherein

the selection of information categories is "at least in part on a profile of the user." The

reference teaches that information categories or "themes" are selected based on the viewer

profile and the EPG (Col 4, Lines 24-65). The nature of the profile in the Bedard reference

"includes information associated with the television programming viewed by the user" in the

form of the channel title (ex. ESPN) as shown in Figure 2. Those of ordinary skill in the art

would recognize that additional information "subcategories" could be included in the profile

to further target programming information.

Claim 19 is met wherein the Cohn et al. reference discloses that information may be

"pushed" to the client (Col 2, Lines 44-55). It is well known in the art that "push"

technology does not require "direct user assistance".

13.   Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al. (US

Pat No. 6,317,791), in view of Robinson (US Pat No. 5,918,014), in further view of Breese et

al. (US Pat No. 6,353,813), in view of Bedard (US Pat No. 5,801,747), and in still further

view of Brodsky (US Pat No. 5,809,471).

Claim 32 is met in view of the aforementioned combination illustrated by the "home

entertainment system" shown in Figure 1 of the Cohn et al. reference. As aforementioned,

the combined references also include the means "for monitoring the television programming"

by extracting keywords from the "closed captioning" of the currently viewed program as

taught through the Brodsky reference. It would have been obvious to one of ordinary skill in

the art at the time of the invention to utilize the extracted keyword teachings of the Brodsky

reference in combination with the attribute "set" composition teachings of the Breese et al.

reference in order to identify the content of viewed programming such that profiles may be

created in order to deliver targeted advertisements related to that content.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

- The Brown et al. reference (US Pat No. 5,887,133) discloses a system and method for

    inserting custom advertisements into requested web documents based on user

    profiles. The actual insertion may be conducted on a remote server or through locally

    cached advertisements.

- The Montero (US Pat No. 6,133,912) reference discloses a method and apparatus for dynamically delivering information to a plurality of subscribers based on their viewer profile.

- The Bruck et al. (US Pat No. 6,268,856) reference discloses a method wherein supplemental content may be suppressed in a WebTV© system.

- The Young et al. (US Pat No. 5,353,121) reference discloses a representative Electronic Program Guide (EPG) that utilizes "themes" or "categories" to organize program information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB
June 3, 2002

JOHN MILLER
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